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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,121	01/26/2001	Stefan Johansson	15292.5	7000

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WORKMAN NYDEGGER (F/K/A WORKMAN NYDEGGER &  
SEELEY)  
60 EAST SOUTH TEMPLE  
1000 EAGLE GATE TOWER  
SALT LAKE CITY, UT 84111

EXAMINER
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WAHBA, ANDREW W

ART UNIT	PAPER NUMBER
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2661

DATE MAILED: 01/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/771,121

Applicant(s)

JOHANSSON ET AL.

Examiner

Andrew W Wahba

Art Unit

2661

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-21 and 23 is/are rejected.
- 7) ☒ Claim(s) 10 and 22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/20/04, 09/24/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

  
PHIRIN SAM  
PRIMARY EXAMINER

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 23 is objected to because of the following informalities: Claim 23 is a system claim that implements a method. Claim 23 depends from claim 13 that is a method claim. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 6-9, 13-16, 18-21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturniolo et al (US Patent 6,154,461) in view of Eng et al (US Patent 5,958,018).

With regard to claims 1 and 13, Sturniolo et al discloses an operating protocol for a mobile terminal roaming between LANs as illustrated by FIG 1. Sturniolo et al discloses that the mobile terminal 36 (wireless communication station) registers with an access point AP1 (column 6, lines 65-67). Sturniolo et al further discloses that the mobile terminal 36 establishes a session for communication with GATEWAY 1 to communicate (receiving/transmitting) with other devices (originator) in the communication system 20 (column 7, lines 40-43). As illustrated by FIG 3, data packets

include a source address (network address) that identifies (identity) the originator (column 10, lines 23-25).

Sturniolo et al, however, does not expressly disclose a verification step based upon the identity of the originator. Eng et al discloses a check as to whether an origination MAC address is registered upon receiving a MAC frame as illustrated by FIG 15 (column 4, lines 59-66). The group of MAC addresses that are registered form a set (predetermined originators).

A person of ordinary skill in the art would have been motivated to employ Eng et al in Sturniolo et al to identify a subset of mobile terminals such as those that are being served by an associated access processor (Eng, column 4, lines 29-32). At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine the check as to whether an origination MAC address is registered as disclosed by Eng et al with communication system disclosed by Sturniolo et al (collectively "Sturniolo-Eng") to obtain the invention specified in claims 1 and 13.

With regard to claims 2 and 14, Sturniolo et al discloses that the mobile terminal 36 establishes a session for communication with GATEWAY 1 (network server) to communicate (receiving/transmitting) with other devices (originator) in the communication system 20 (column 7, lines 40-43). Eng et al discloses a check as to whether an origination MAC address (name of a network server) is registered upon receiving a MAC frame as illustrated by FIG 15 (column 4, lines 59-66). The group of MAC addresses that are registered form a set.

With regard to claims 3, 4, 8, 15, 16 and 20, Eng et al discloses a check as to whether an origination MAC address (originator) is registered (determining / comparing) upon receiving a MAC frame as illustrated by FIG 15 (column 4, lines 59-66). Address translation tables (address translation) such as that disclosed by Eng et al (column 4, lines 61-66) are well known in the art. Whether a check as to whether an address is registered occurs before or after address translation, an address is ultimately verified. Sturniolo et al discloses that the mobile terminal 36 establishes a session for communication with GATEWAY 1 (network server) to communicate (packet data session) with other devices (originator) in the communication system 20 (column 7, lines 40-43).

With regard to claims 6 and 18, Eng et al discloses a check as to whether an origination MAC address (originator / network address) is registered upon receiving a MAC frame as illustrated by FIG 15 (column 4, lines 59-66). Sturniolo et al discloses that the mobile terminal 36 establishes a session for communication with GATEWAY 1 to communicate (packet data session) with other devices (originator) in the communication system 20 (column 7, lines 40-43).

With regard to claims 7 and 19, data packets include a source address (IP address) as illustrated by FIG 3 (Sturniolo column 3, lines 23-25).

With regard to claims 9 and 21, network servers are typically identified by an Internet host domain name.

With regard to claim 23, Eng et al discloses a check as to whether an origination MAC address (originator) is registered (predetermined) upon receiving a MAC frame as

illustrated by FIG 15 (column 4, lines 59-66). Sturniolo et al discloses that the mobile terminal 36 establishes a session for communication with GATEWAY 1 to communicate (packet data session) with other devices in the communication system 20 (wireless communication network) (column 7, lines 40-43).

4. Claims 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturniolo et al (US Patent 6,154,461) in view of Eng et al (US Patent 5,958,018) in further view of Koyama (US Patent 5,654,957).

Sturniolo-Eng does not expressly disclose describe the makeup of the mobile station. With regard to claim 11, Koyama et al discloses the packet communication unit also includes a processor 31 (computer executable/microprocessor) in which a memory (computer-readable medium) is inherent (Koyama column 5, lines 39-45).

A person of ordinary skill in the art would have been motivated to employ the packet communication unit disclosed by Koyama in the mobile terminal disclosed by Sturniolo-Eng to provide a display in the mobile station (Eng column 5, lines 21-27). At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to which the invention pertains to combine Koyama with Sturniolo-Eng to obtain the invention in claim 11.

With regard to claim 12, Koyama et al further discloses that the packet communication unit also includes a processor 31 (processing means) in which a memory (memory means) inherent (Koyama column 5, lines 39-45). Koyama also disclose a keyboard (interface circuitry) for inputting information required for operation (Koyama column 5, lines 21-27).

5. Claims 5 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sturniolo et al (US Patent 6,154,461) in view of Eng et al (US Patent 5,958,018) in further view of Lahtinen (US Patent 5,351,235).

Sturniolo-Eng does not disclose a received network address is received in a short message, the short message being received from a short message service. With regard to claims 5 and 17, Lahtinen discloses a GSM short message service (short message service) in which mobile phone that receives the message (short message) containing the address (network address) of the transmitting terminal equipment (column 8, lines 2-8).

A person of ordinary skill in the art would have been motivated to combine Sturniolo-Eng and Lahtinen to transmit the messages to all mobile phones in the area or broadcast service (Lahtinen, column 1, lines 64-68). At the time the invention was made, therefore, it would have been obvious to one of ordinary skill in the art to obtain the invention as specified in claims 5 and 17.

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

### ***Information Disclosure Statement***

7. The Office requests that applicant resend a copy of the Hoff, Meyer and Cai references listed as items 20-22 of the IDS submitted 09/20/2004.

***Allowable Subject Matter***

8. Claims 10 and 22 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew W Wahba whose telephone number is (571) 272-3081. The examiner can normally be reached on M-F 8:30-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kenneth N Vanderpuye can be reached on (571) 272-3078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Respectfully Submitted,

Andrew Wahba *AW*  
Patent Examiner  
January 21, 2005

  
PHIRIN SAM  
PRIMARY EXAMINER